

Notice of Allowability

Application No.

10/720,131

Examiner

Margaret G. Moore

Applicant(s)

ASAINÉ, MASAYA

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to communication filed 11/8/05.
2. ☒ The allowed claim(s) is/are 1 to 17, 20, 21.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

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1. The following is an examiner's statement of reasons for allowance: In view of applicants' amendment and remarks filed 11/8/05 the instant claims are in condition for allowance. The Examiner provides the following remarks only to reinforce applicants' remarks.

While the Examiner maintains the belief that the claimed component (c) is anticipated by the specific showing of a SiH terminated siloxane on lines 20 to 50 of column 5, this claimed component cannot be considered alone. It must be used in combination with the specific siloxane (a) having alkenyl groups only at both ends of the siloxane chain. The selection of such a combination of reactants is not adequately taught by Okinoshima et al. since one must select from various siloxanes within the breadth of (1) on column 3, in addition to the selection of the SiH terminated siloxane. Okinoshima et al. actually teach away from the combined use of (a) and (c) as claimed because the composition therein is an elastomer or a rubber and to form such a composition cross-linking must occur. The selection of components (a) and (c) as claimed will result only in a chain extended silicone composition, not a rubber or elastomer. Okinoshima et al. refer to the composition therein as a rubber throughout the disclosure and indicate on column 1, line 41, that rubber and elastomer refer to the same general product. Given the totality of teachings in Okinoshima et al., the skilled artisan would not have been motivated to select (a) and (c) as claimed due to the fact that this will not be expected to provide an elastomeric product.

As an aside the Examiner cites page 943 of the Kirk-Othmer Encyclopedia of Chemical Technology, Silicones, which states that elastomers must be crosslinked to provide elastomeric properties.

Further evidence of the non-obviousness of the claims is the required penetration limitation. Patentees are silent as to such a property and as such provide no motivation to optimize/modify the composition therein to arrive at the claimed penetration value. In addition, one cannot assume that such a limitation will inherently be found in the prior art because, as noted supra, the prior art is drawn to an elastomeric product.

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Finally, to emphasize the invention, the Examiner notes that the claimed composition exclude the presence of any SiH containing siloxane other than ones having an SiH group only at both ends of the molecular chain.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
11/19/05